

AMENDMENTS TO THE DRAWINGS

Applicant submits herewith replacement drawing sheets for FIGS. 17 and 18. In FIG. 17, printed text 69A and 69B have been added to faceplate 68. In FIG. 18, graphic text 69C has been added to faceplate 68. No new matter has been added by way of this amendment.

REMARKS

This is responsive to the Office Action dated September 12, 2006. Applicant has amended claim 7. Claims 1-34 are pending, with claims 18-34 being withdrawn.

Claim Objections

In the Office Action, the Examiner objected to claim 1 because the Examiner was unsure of which version of claim 1 Applicant wishes to keep. In the Applicant's previous Response mailed on July 12, 2006, Applicant inadvertently provided a previous version of claim 1. In the present Response, Applicant has provided the most current version of claim 1. Claim 1 now recites a "medical device programmer comprising . . . a display . . . wherein the plate member covers at least a portion of the display . . ." Applicant respectfully requests that the objection to claim 1 be withdrawn.

Drawing Objections Under 37 C.F.R. § 1.83(a)

In the Office Action, the drawings were objected to under 37 C.F.R. § 1.83(a) on the basis of failing to show every feature of the invention specified in the claims, and in particular, the "printed information on the plate member." Applicant has amended FIGS. 17 and 18 to illustrate examples of printed information on a plate member. Paragraphs 85 and 127 of Applicant's disclosure have also been amended to reflect the changes to the drawings. The amendments are fully supported by Applicant's originally filed disclosure and no new matter has been entered by way of the amendment to FIGS. 17 and 18 or the specification. Accordingly, Applicant respectfully requests that the objection to the drawings be withdrawn.

Claim Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 1 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stein et al. (U.S. 2004/0230246). Claims 1, 6, 9-11, and 13-17 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Slipy et al. (U.S. 5,848,152) in view of Haller et al. (U.S. 6,804,558) and further in view of Wycherley et al. (U.S. 6,898,283). Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slipy et al. in view of Haller et al. and Wycherley et al. as applied to claim 1, and further in view of Coutre (U.S.

5,317,506). Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Slipy et al. in view of Haller et al. and Wycherley et al. as applied to claim 1 above, and further in view of Stroebel et al. (U.S. 6,754,527).

Applicant respectfully traverses the rejections because the applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Independent Claim 1

Applicant's independent claim 1 is directed toward a medical device programmer that includes a first housing member, a second housing member, a display, and a plate member attached to the second housing member, where the plate member covers at least a portion of the display and includes a transparent area that exposes the display for viewing, and where the plate member is printed with information to identify a programmer type associated with the medical device programmer.

The cited references, alone or in combination, fail to teach or suggest the invention of Applicant's independent claim 1. For example, the cited references do not teach or suggest a medical device programmer comprising a first housing member, a second housing member, a display, and a plate member attached to the second housing member. The Office Action contends that "the cell phone [in Slipy et al.] is a programmer because it is *capable* of inserting or encoding specific operating instructions into another machine or apparatus (i.e. another cell phone or an IMD as taught in Figure 6A of Haller)." (Emphasis in original.) Applicant respectfully traverses.

Applicant's claim 1 clearly recites a medical device programmer. Thus, the fact that the radiotelephone handset taught by Slipy et al. may be capable of programming another radiotelephone handset is irrelevant. The Office Action did not provide any support for the assertion that the radiotelephone handset in Slipy et al. is capable of inserting or encoding specific operating instructions into another machine or apparatus, much less a medical device.

In addition, Haller et al. does not teach that a cell phone is a medical device programmer. The Haller et al. reference is directed toward a communications module that is configured to

operate in conjunction with a plurality of different implantable medical devices (IMD).¹ While the communications module may be incorporated into or attached directly to a housing of a cell phone², Haller et al. does not teach or suggest that the cell phone is a medical device programmer.

In the Haller et al. system, an IMD receives information or data from, or sends information or data to, the communications module, not the cell phone.³ The communication module does not include a first housing member, a second housing member, a display and a plate member attached to the second housing member. Accordingly, neither Slipy et al., which relates to a radiotelephone handset, nor the other references of record, teach or suggest a medical device programmer comprising a first housing member, a second housing member, a display and a plate member attached to the second housing member.

The references of record also fail to teach or suggest a plate member that is printed with information to identify a programmer type associated with the medical device programmer, as recited by Applicant's independent claim 1. As the Office Action recognized, Slipy et al. does not disclose that the plate member is printed with information.⁴ However, the Office Action relied on knowledge in the art to find a teaching for a plate member printed with information to identify a programmer type. Specifically, the Office Action stated that, "it is well known in the cell phone art to print a logo or trademark symbol on the faceplate of the programmer and the examiner considers that the company trademark identifies the programmer as a communication device."⁵

Applicant respectfully traverses the Office Action's assertion of official notice. The Office Action has not provided any support that it is well known in the cell phone art to print a logo or trademark symbol on the faceplate of a programmer. As established above, there is no teaching or suggestion in the prior art for the assertion that a cell phone is a medical device programmer. In fact, Haller et al. suggests the opposite by teaching a communication module that must be used in conjunction with the cell phone in order to communicate with a medical device.

¹ Haller et al. at col. 18, ll. 62-64.

² *Id.* at col. 21, ll. 22-24.

³ *Id.* at col. 18, ll. 52-54.

⁴ Office Action at page 5, item 8.

The Office Action also looked to Wycherley et al. to cure the deficiency in Slipy et al. More specifically, the Office Action stated that “Wycherley discloses a plate member . . . that is printed with information to identify a programmer type.”⁶ However, Wycherley et al. does not teach or suggest a plate member that is printed with information to identify a programmer type associated with the medical device programmer. Wycherley et al. describes a removable cover for a mobile phone that has graphics and other indicia printed on an outward-facing surface.⁷ The Office Action contends that because Wycherley et al. teaches visual indications that relate to a “particular theme,” the graphics and other indicia taught by Wycherley et al. identify a programmer type. Applicant respectfully disagrees.

In the Wycherley et al. reference, a “particular theme” may be, for example, seasonal covers or event covers.⁸ On the other hand, Applicant’s claim 1 refers to a medical device programmer that includes a plate member that is printed with information to identify a programmer type. Examples of “programmer types” provided in Applicant’s disclosure include, but are not limited to, types of therapy delivered by the medical device, or model types.⁹ Wycherley et al. does not teach or suggest a medical device programmer or a plate member that is printed with information to identify a programmer type.

The Office Action has not identified any teaching in the prior art of a motivation to combine the teaching of the applied references to arrive at the medical device programmer recited in Applicant’s claim 1. In particular, the Office Action fails to provide a motivation in the art for modifying a medical device programmer with the printed cell phone faceplate of Wycherley et al., which does not even identify a medical device programmer type, to arrive at medical device programmer including a plate member printed with information identifying a programmer type. Without relying on hindsight, it is unclear from the Office Action why one would have been motivated to modify a medical device programmer to include a printed cell phone faceplate, and then to further modify the printed “theme” on the faceplate taught by Wycherley et al. to identify a medical device programmer type.

⁵ *Id.*

⁶ Office Action at page 5, item 8.

⁷ Wycherley et al. at col. 3, ll. 41-43.

⁸ *Id.* at col. 7, ll. 17-18.

⁹ See, e.g., Applicant’s disclosure at paragraph 22.

As Applicant's disclosure recognizes, a plate member that is printed with information to identify a programmer type associated with a medical device programmer provides many advantages. For example, a plurality of generic medical device programmers may be manufactured and stored until a specific type of programmer is ordered for a particular medical device. After a generic medical device programmer is programmed with the appropriate software, a faceplate conforming to the type of medical device may be placed within the programmer.¹⁰

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify Slipy et al. reference in view of the Wycherley et al. and Haller et al. references is unsupported by any substantial evidence in the record.

Claim 1 was also rejected under 35 U.S.C. § 103(a) as being obvious over Stein et al. because Stein et al. "discloses a printed label with information to identify a programmer type associated with the medical device programmer."¹¹ Applicant respectfully traverses the rejection. While recognizing that Stein et al. fails to disclose that the printed label is on the plate member, the Office Action relied on the assertion that "rearranging parts of an invention involves only routine skill in the art"¹² to support the conclusion that Stein et al. teaches or suggests a printed label on a plate member. However, even if putting printed information on the plate member, rather than on a rear of a controller case, as taught by Stein et al.¹³, involves only routine skill in the art, the Office Action still failed to identify any teaching or suggestion that would have motivated a person skilled in the art to modify Stein et al. to include a printed information identifying a programmer type. Applicant's disclosure, on the other hand, describes specific advantages of including printed information on a plate member of an medical device programmer. For example, the plate members printed with information identifying a programmer type enable a plurality of generic programmers to be manufactured and stored until a specific type of programmer is ordered. One of the generic programmers may then be selected

¹⁰ *Id.* at paragraph 87.

¹¹ Office Action at page 4, item 7.

¹² *Id.*

¹³ Stein et al. at paragraph 37.

from the stockpile and programmed with the appropriate software. Thereafter, the plate member designating the programmer type may be placed on the programmer.¹⁴

Stein et al. does not provide any details regarding the content of its “adhesive instruction label.” Stein et al. merely states that the label provides “information to the patient regarding the use and operation of controller 10.”¹⁵ Based on this disclosure in Stein et al., the Office Action contends that the Stein et al. label “identifies the programmer type because the instructions define the program.”¹⁶ However, nothing in the Stein et al. references even suggests that the “instruction label” includes instructions specific to a programmer type, much less instructions that identify the programmer type. The label may include one of many different types of information regarding the use and operating of the controller. For example, the instructions may be as general as specifying how to turn the controller on and off, in which case the instructions would not serve to identify a programmer type.

The Office Action relies on an improper inherent disclosure in Stein et al. when assuming that the Stein et al. instruction label includes information that defines a program for the cardiac rhythm management controller in Stein et al. The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”¹⁷ The Examiner must provide a basis in fact and/or technical reasoning to reasonably support a determination that an allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.¹⁸ No reasonable support has been provided for the determination that the instruction label in Stein et al. defines a program for the cardiac rhythm management controller.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant’s independent claim 1 under 35 U.S.C. § 103(a). Withdrawal of this rejection is requested.

Dependent Claims 2-6 and 9-17

Claims 2-6 and 9-17 are dependent upon Applicant’s independent claim 1, and, accordingly, are also patentable over the cited references. In addition, Applicant notes that the

¹⁴ See, e.g., Applicant’s disclosure at paragraphs 87-89.

¹⁵ Stein et al. at paragraph 37.

¹⁶ Office Action at page 4, item 7.

¹⁷ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP 2112.

applied references fail to disclose or suggest the inventions defined by Applicant's dependent claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. Applicant addresses some of the dependent claims below for purposes of illustration.

With respect to the rejection of claims 14-16, the Office Action recognized that Slipy et al. does not disclose two separate circuit boards, as recited by claim 14. However, the Office Action stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to enclose two circuit boards within the first and second housing members since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art."¹⁹ Even if Slipy et al. included two circuit boards within first and second housing members, which Applicant does not agree with, nothing in Slipy et al. (nor the other cited references) teaches or suggests that the first circuit board includes telemetry circuitry and the second circuit board includes a display and display circuitry, as recited by Applicant's claim 15.

As discussed above, in order to establish that a certain characteristic is present in the prior art, it is not sufficient to establish the inherency of that result or characteristic.²⁰ Rather, the Examiner must show that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.²¹ However, no reasonable support has been provided for the determination that an antenna and display in Slipy et al. are necessarily mounted on first and second circuit boards, respectively. Accordingly, Slipy et al. does not render Applicant's claim 15 obvious.

With respect to the rejection of claim 17, the Office Action stated that, "Haller discloses that the first circuit board includes an internal antenna . . . since telemetry module 101 is on the first circuit board and the internal antenna is in the telemetry module, the internal antenna is also on the first circuit board."²² Applicant respectfully disagrees with the Office Action's analysis of Haller et al. The Office Action is silent as to whether Haller even teaches or suggests a programmer comprising a first circuit board and a second circuit board, much less a first circuit board including telemetry circuitry and a second circuit board including a display and display

¹⁸ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 2112.

¹⁹ Office Action at page 6, item 14.

²⁰ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP 2112.

²¹ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 2112.

circuitry, as recited by Applicant's claim 15, from which claim 17 depends. Thus, the fact that Haller et al. might disclose a circuit board including an internal antenna does not render Applicant's claim 17 obvious.

Furthermore, at column 24, lines 54-60, to which the Office Action cites, Haller et al. merely states that the telemetry module (101) includes an antenna or coil. Haller et al. does not teach that an internal antenna is mounted on a circuit board separate from a circuit board on which a display and display circuitry are mounted. In fact, Haller et al. states that "telemetry module 101 preferably comprises an external RF telemetry antenna . . . ,"²³ whereas Applicant's claim 17 recites an internal antenna. Accordingly, Haller et al. fails to teach or suggest each and every element of Applicant's claim 17, and the rejection should be withdrawn.

In view of the fundamental deficiencies evident in the cited references, it is not necessary to discuss in detail the additional patentable differences presented by the remaining dependent claims. In reserving comment, however, Applicant neither admits nor acquiesces in the Examiner's interpretation with respect to the teachings in such applied references or with respect to any features set forth in the dependent claims.

Allowable Subject Matter

In the Office Action, the Examiner indicated that claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With this Amendment, Applicant has amended claim 7 to include all of the limitations of its base claim and any intervening claims. Claim 7 and claim 8, which depends from claim 7, are in condition for allowance. Notice to that effect is respectfully requested.

²² Office Action at page 7, item 15.

²³ Haller et al. at col. 24, lines 61-62 (emphasis added).

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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